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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: HERBERT DAMSOHN ET AL.

Serial No.: 08/743,002

Group Art Unit: 3743

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Examiner: L. LEO

RECEIVED

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Title: HEAT EXCHANGER FOR EXHAUST GAS COOLING

TECHNOLOGY CENTER 3700

COMMUNICATION REQUESTING WITHDRAWAL OF FINAL OFFICE ACTION
ISSUED DUE TO UNAUTHORIZED DEPOSIT ACCOUNT CHARGE

Box

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

A final Office Action dated May 25, 1999 has been received pursuant to a Request for Continued Prosecution Application under 37 C.F.R. 1.53(d) filed May 10, 1999 (hereinafter, "said Request"). However, said Request expressly requested that the application filing fee be deferred (see item 6. on page 2 of said Request, as well as the last paragraph on page 4 of said Request). No authorization was given to charge the filing fee to the undersigned firm's Deposit Account (see item 8. on page 2 of said Request), which is apparently what was done. The Deposit Account authorization in the Petition for Extension of Time accompanying said Request only applied to the extension fee, and not to the application filing fee.

The filing fee was deferred specifically to avoid the situation that has now occurred, i.e., the issuance of a final first Action prior to the filing of a Preliminary Amendment.

This situation should not have occurred, since the filing fee was expressly deferred, and the undersigned was awaiting a Notification of Missing Parts requiring payment of the filing fee when the improper final Action was received.

KMA
Also attached is a copy of a portion of the Report in Response to Concerns Raised at the Mechanical Focus Session, November 10, 1998, issued by the Patents Business Goal IV (Quality) Umbrella Committee of the U.S. Patent and Trademark Office, recommending at Category 5, page 6, that Examiners contact the attorney before making a first action final in a CPA to determine if an amendment was intended.

In view of the above, it is respectfully requested that the final Office Action be withdrawn, the application filing fee be credited back to the undersigned firm's Deposit Account, and a Notice of Missing Parts be issued, requiring payment of the application filing fee.

If there are any questions, feel free to contact the undersigned by telephone.

Respectfully submitted,

June 25, 1999

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REPORT IN RESPONSE TO CONCERNS RAISED

At The

MECHANICAL FOCUS SESSION

November 10, 1998

**United States Patent and Trademark Office
Technology Centers 3600 and 3700**

INTRODUCTION

This is a report on the follow-up by Technology Centers (TCs) 3600 and 3700 to the Mechanical Focus Session held last November 10. At that time you, as practitioners in the mechanical technologies, attended a focus session with PTO representatives from TCs 3600 and 3700. We gathered much information on your concerns about our quality and customer service. We subsequently transcribed the numerous notes we made at the focus session and mailed you a letter with copies of our notes in December of 1998. In our letter, we promised to follow up and send you a report on actions taken to address your concerns.

We devoted considerable time to analyzing the information that we gathered at the focus session with a view toward placing it in a form that would help us substantively address each concern. We condensed the numerous concerns revealed in our notes to a comprehensive list of items that we call "dissatisfiers". Related dissatisfiers were grouped into 25 categories. After that we discussed each category and decided which categories could be addressed by our technology centers and which categories clearly were the responsibility of an office outside the TCs. Finally, we drafted a detailed report for our directors and made recommendations for an approach to each category of dissatisfier.

In this report, we will inform you on what we have done so far and what we plan to do in the future to address your concerns. We have taken every concern seriously. Some of your concerns have already been constructively addressed in our on-going efforts to improve customer satisfaction under Patent Business Goal IV which states that "we will exceed our customers' quality expectations through the competencies and empowerment of our employees". Others are in the process of being constructively addressed by initiatives and programs proposed or in place. Still others require more specific information and data before a proposed solution can be effected.

We sincerely thank you for the time and attention you gave to the focus session. We realize that we cannot achieve our goal of exceeding your expectations unless we better understand what it is that you expect. The feedback you gave us is invaluable. We hope that through a cycle of gathering data and information through such mechanisms as focus sessions and surveys, analyzing that data, and informing and educating our personnel based on our analyses, we will be able to continue making significant progress toward Goal IV.

DISSATISFIERS – THE 25 CATEGORIES

- 1 Matching papers (other than drawings) with the file after allowance
- 2 After final practice
- 3 Long delay when an oral hearing is requested in appealed applications
- 4 Certified copy requests lost
- 5 First actions on CPAs
- 6 Communicating with Drafting Branch
- 7 Fairness regarding cost of errors
- 8 Faxes
- 9 File handling
- 10 Filing receipts errors
- 11 Final rejection practice
- 12 Forms
- 13 Incomplete Office actions
- 14 Interview practice
- 15 Missing parts letters
- 16 Office action substance and formalities
- 17 PALM flag and exceptions lists
- 18 Paper handling other than fax and status inquiry
- 19 Customer perception regarding examiners' perspective
- 20 Timeliness of action on reexaminations and reissues
- 21 Restriction practice
- 22 Search
- 23 Status inquiries
- 24 Voice mail
- 25 Work credit policy

The best way for customers to minimize the chance of "lost orders" is to e-mail (certdiv@uspto.gov) or fax (703-305-8759) orders directly to OPR and pay either by PTO deposit account or credit card. (Note MPEP 1730, Miscellaneous).

Furthermore, to assist customers the Office of Public Records publishes a notice in the OG each month detailing the status of certification services product-by-product. The notice gives information on how to order and the telephone and fax numbers, and the e-mail address.

Category 5 – First actions on CPAs

Statement of the Problem:

Some customers believe action by the Examiner occurs too quickly on newly filed CPAs. This leaves insufficient time for preliminary amendments or interviews that may resolve issues. An additional concern is the tendency toward final rejections on first action that are sometimes inappropriate.

Response:

It is important to understand that the continued prosecution application (CPA) procedure is intended to provide a rapid way to continue prosecution without after final constraints and without the potential delay from filing a completely new application. Applicants and their attorneys should be aware that Examiners promptly take up these cases to achieve that objective. In fact, the CPAs filed are listed on the Examiners docket report with the amended application section to insure a rapid response. Thus applicants and their attorneys should expect a quick first action in CPAs, and should endeavor to prepare and file any amendments desired promptly.

However, Examiners should be aware that in order to expedite continued prosecution of the application, applicants often seek to revise the record by amendment prior to the first action in the CPA. Consequently, it is advantageous to insure, to the extent practical, that the elements necessary to expedite prosecution are in the case, including any intended amendments. Where the record might reflect the intention to file a preliminary amendment in a CPA it would behoove the Examiner to anticipate that such a preliminary amendment may have been filed and to verify with the attorney by phone, if necessary, whether the amendment in fact has been filed. Moreover, in any CPA it would be "customer friendly" to contact the attorney before making a first action final in a CPA to determine if an amendment was intended. In the spirit of Goal IV, this practice will be emphasized to Examiners by memorandum from the QASs in each of the mechanical TCs

Category 6 – Communicating with Drafting Branch

Statement of the Problem:

Customers experience significant difficulties in communicating with Drafting Branch. It is often difficult to have formal drawings matched with the file. Attorneys